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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,677	03/30/2000	Stephan Meyers	4925-39	8738
7590	11/24/2004		EXAMINER	
Michael C Stuart Cohen Pontani Lieberman & Pavane 551 Fifth Avenue Suite 1210 New York, NY 10176			VAN DOREN, BETH	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 11/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/538,677	MEYERS, STEPHAN <i>SB</i>	
	Examiner	Art Unit	
	Beth Van Doren	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 September 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7, 9, 10 and 12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-7, 9, 10, and 12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Final Office Action in response to communications received 09/18/2004. Claim 11 has been canceled. Claims 1 and 12 have been amended. Claims 1-7, 9-10, and 12 are now pending in this application.

Response to Arguments

2. Applicant's remarks with regards to the 35 USC § 112, second paragraph rejections have been considered and are persuasive. Therefore, Examiner withdraws these rejections.

3. Applicant's remarks with regards to the 35 USC § 102 rejections based on Rio Portable MP3 Player bundled with MusicMatch Jukebox (references A-D, set forth below) have been considered but they are not persuasive. In the remarks, Applicant argues that (1) references A-D do not constitute prior art under 35 USC § 102(a) and should be a 35 USC § 103 rejection, and that Rio Portable MP3 Player bundled with MusicMatch Jukebox does not teach or suggest (2) a portable media player having a processor operatively connected to said user-manipulable control dedicated for generating a signal indicating a user-supplied rating of a currently played media content in response to one of the predefined categories of preferences because the Rio Portable MP3 player does not run the Music Match Jukebox software, (3) ranking the media content in response to the user-supplied ratings in the ratings list and selectively downloading and playing media content in said memory based on the user-supplied ratings list, or (4) the processor is operable for continuously updating a user-supplied rating of the media content based on signals input by the user during subsequent playing of the media content.

In response to argument (1), Examiner respectfully disagrees. Examiner has rejected the claims over the product of "Rio Portable MP3 Player bundled with MusicMatch Jukebox".

Reference D discloses the use of the MusicMatch Jukebox with the Rio Portable MP3 Player as one product. References A-C disclose features of the product Rio Portable MP3 Player bundled with MusicMatch Jukebox, and therefore show features inherent in reference D. Therefore, references A-D are acceptable to use together as multiple references under MPEP 2131.01 because the references are used to show that a characteristic not disclosed in the reference is inherent. Therefore, Examiner maintains the appropriateness of the 35 USC § 102 rejection.

In response to argument (2), Examiner respectfully disagrees. The claims recite a “processor operatively connected to said user-manipulable control and to said memory device for selectively downloading and playing the stored media contents”. Thus, the processor is effectually connected to the control and memory in order to download and play the media contents. Since the preamble recites “a portable media player and rating apparatus for rating media content” and since the term “download” means to transfer (data or programs) from a server or host computer to one's own computer or device, it appears that the processor is located remotely from the media player, though the two are functionally connected. See at least reference A, page 1 and page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3, wherein the processor is used in conjunction with the memory and the control to selectively download to the player playlists and ratings and play the media contents. The music is positioned to be played based on the user-supplied ratings.

In response to argument (3), Examiner again points out that downloading means to transfer from a server or host computer to one's own computer or device, thus again implying two devices – the media player and the computer. A user applies ratings to music and the music

is sorted based on these user-supplied ratings in at least reference A, page 1, page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3. After the sorting occurs, the music is downloaded to the media player and played for the user.

In response to argument (3), Examiner respectfully disagrees. The processor stores the ratings assigned to the media content by the user. These ratings can be changed or updated by the user at any point. Therefore, Rio Portable MP3 Player bundled with MusicMatch Jukebox is capable of continuously updating a user-supplied rating of the media content based on signals input by the user during subsequent playing of the media content. See reference A, page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 6-7, and 9-12 are rejected under 35 U.S.C. 102(a) as being anticipated by *Rio Portable MP3 Player bundled with MusicMatch Jukebox*. The following references disclose the features of the product:

i. “MusicMatch and Xing Technology introduce MusicMatch Jukebox” from the press releases of www.musicmatch.com (referred to herein as reference A);

- ii. "MusicMatch delivers breakthrough music personalization service in new MusicMatch Jukebox" from the press releases of www.musicmatch.com (referred to herein as reference B);
- iii. Screenshots of www.musicmatch.com retrieved from archive.org (referred to herein as reference C, and which specifies the use of the MusicMatch Jukebox software with the Rio Player); and
- iv. Screenshots from www.diamonmmm.com of **Rio PMP 300** retrieved from archive.org (referred to herein as reference D, Rio PMP 300 is the player disclosed as used with MusicMatch Jukebox in reference C, page 3).

5. As per claim 1, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* teaches a portable media player and rating apparatus for rating media content, comprising:

a user-manipulated control dedicated for generating a signal indicating a user-supplied rating of currently played media content in response to a user-supplied rating, the user-supplied rating corresponding to one of a plurality of predefined categories of preferences (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, and reference C, page 1, sections 1 and 2, and page 2, sections 1 and 2, wherein the user generates a signal via his/her PC and/or playing device, the signal indicating a rating of the currently played media content. The user's rating is a preference rating which helps build the user's profile);

the portable media player (See at least reference B, page 1, sections 2 and 3, and reference C, page 3) comprising:

a memory device for storing media contents and a ratings list comprising a list of user supplied ratings associated with the stored media contents (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3, which discloses a memory device that stores media contents and information about the media contents); and

a processor said processor operatively connected to said user-manipulable control and to said memory device for selectively downloading and playing the stored media contents, for receiving the signal from said user-manipulable control, and for associating the user-supplied rating indicated by the signal with the currently played media content, wherein said processor is further operable for ranking the media content in response to the user-supplied ratings in the ratings list and selectively downloading and playing media content in said memory based on the user-supplied ratings list (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3, wherein the processor is used in conjunction with the memory and the control to selectively download playlists and ratings and play the media contents. The music is positioned to be played based on the user-supplied ratings),

and said user-manipulable control includes input controls for indicating a positive rating and a negative rating, said processor being operative to move the currently playing content toward one of the top and the bottom of the ratings list if the positive rating is indicated and move the currently playing content toward the other one of the top and the bottom of the ratings list if the negative rating is indicated, and wherein said processor is further operable for continuously updating a user-supplied rating of the media content based on signals input by the user during

subsequent playing of the media content (See reference A, page 1, sections 1 and 2, and page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3, wherein the music is sorted based on the user-supplied ratings. The dynamic system allows for updating).

6. As per claim 2, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* teaches a device wherein said processor receives the signal from said user-manipulable control as said processor plays the media content stored in said memory device (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3, wherein the processor receives the signal).

7. As per claim 3, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* teaches a device wherein the user-manipulable control includes a switch having a plurality of depressible buttons, each of said plurality of depressible buttons corresponding to one of said predefined categories of preferences (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, and reference C, page 1, sections 1 and 2, and page 2, sections 1 and 2, wherein the user generates a signal via his/her PC and/or playing device. A switch is a device that channels incoming data from any of multiple input ports to the specific output port).

8. As per claim 6, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* teaches a device wherein the user-manipulable control is attachable to a portion of the headphone (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, reference C, page 1, sections 1 and 2, and page 2, sections 1 and 2, and reference D, pages 3 and 6, wherein the user generates a

signal via his/her PC and/or playing device. The playing device is attachable to the PC, and the headphones are attachable to the PC and playing device).

9. As per claim 7, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* discloses a device wherein said portion of a headphone includes a headphone cord (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, reference C, page 1, sections 1 and 2, and page 2, sections 1 and 2, and reference D, pages 3 and 6, wherein the user generates a signal via his/her PC and/or playing device. The playing device is attachable via a cord to the PC, and the headphones are attachable to the PC and playing device via a cord).

10. As per claim 10, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* teaches a method wherein the processor is connectable to a server for transmitting the ratings list to a server, whereby the ratings list of user-supplied ratings is comparable with ratings lists of other users (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3, wherein the user receives recommendations based on the comparing of the user with the community).

12. As per claim 12, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* teaches a device wherein said processor is operable for receiving recommendations of items from the server based on ratings of the items by other users with similar preferences (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, reference B, page 1, sections 1-3, and reference C, page 1, sections 1 and 2, page 2, sections 1 and 2, and page 3, wherein the user receives recommendations based on the comparing of the user with the community).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rio Portable MP3 Player bundled with MusicMatch Jukebox* in view of Gordon et al. (U.S. 6,208,335).

15. As per claim 4, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* discloses a device wherein said user-manipulable control includes depressable buttons, each of said buttons corresponding to one of said plurality of predefined categories of preferences as well as a remote located in the headphone cord (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, and reference C, page 1, sections 1 and 2, and page 2, sections 1 and 2, wherein the user generates a signal via his/her PC and/or playing device, the signal indicating a rating of the currently played media content. The user's rating is a preference rating which helps build the user's profile. See also reference D, pages 3 and 6). However, Thomson does not expressly disclose that said user-manipulable control includes a multi-position switch movable among different positions, each of said positions corresponding to one of said plurality of predefined categories of preferences.

Gorden et al. discloses a user-manipulable control includes a multi-position switch movable among different positions, each of said positions corresponding to one of said plurality of predefined categories of preferences (See column 2, lines 28-31, and column 6, lines 39-49,

which discloses a joystick associated with the remote control and used, with its multi-position switch, to select predefined regions).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a multi-position switch in the user-manipulabe control device because said switch would increase the ease of use of the control device for the user. A multi-position switch allows a user to more easily and more rapidly navigate through and input rating information (See Gorden et al., column 2, lines 13-17). Multi-position switches are old and well known to remote controls.

16. As per claim 5, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* discloses a device wherein said user-manipulable control includes depressable buttons as well as a remote located in the headphone cord (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, and reference C, page 1, sections 1 and 2, and page 2, sections 1 and 2, wherein the user generates a signal via his/her PC and/or playing device, the signal indicating a rating of the currently played media content. The user's rating is a preference rating which helps build the user's profile. See also reference D, pages 3 and 6). However, Thomson does not expressly disclose that said user-manipulable control includes a multi-position switch with a pivotable lever.

Gorden et al. teaches a device wherein the multi-position switch includes a pivotable lever (See column 2, lines 28-31, and column 6, lines 39-49, which discloses a joystick associated with the remote control. The multi-position joystick has a pivotable lever).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a multi-position switch with a pivotable lever in the user-manipulabe control device

because said switch with a pivotable lever would increase the ease of use of the control device for the user. A multi-position switch allows a user to more easily and more rapidly navigate through and input rating information (See Gorden et al., column 2, lines 13-17). Multi-position switches with pivotable levers are old and well known to remote controls.

17. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Rio Portable MP3 Player bundled with MusicMatch Jukebox*.

18. As per claim 9, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* discloses a device wherein said user-manipulable control indicates a user-supplied rating of currently played media content in response to a user-supplied rating, the user-supplied rating corresponding to one of a plurality of predefined categories of preferences and sorting the lists based on these preference ratings (See at least reference A, page 1, sections 1 and 2, and page 2, section 1, and reference C, page 1, sections 1 and 2, and page 2, sections 1 and 2, wherein the user generates a signal via his/her PC and/or playing device, the signal indicating a rating of the currently played media content. The user's rating is a preference rating which helps build the user's profile). However, *Rio Portable MP3 Player bundled with MusicMatch Jukebox* does not expressly disclose a most positive rating, a neutral rating, and a most negative rating, said processor being operative to move the currently playing content to the top of the rating list if the most positive rating is indicated and move the currently playing content to the bottom of the ratings list if the most negative rating is indicated.

Rio Portable MP3 Player bundled with MusicMatch Jukebox discloses preference ratings and sorting song lists using these preference ratings. It would have been obvious to one of

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ordinary skill in the art at the time of the invention to include a most positive rating, a neutral rating, and a most negative rating and to move the currently playing content to the top or the bottom of the list using this rating in order to increase the ease of finding media in the collection that appeals to the user by sorting the media in a best to worst listing. See at least reference C, page 2, section 1.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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*lwd
bvd*

November 22, 2004

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER
AU 3623